

TFW 1636
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May 16, 2006

Mail Stop - Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: U.S. Application No. 08/915,004
Filed: August 20, 1997
Title: Novel Proteins and Methods for Producing the Proteins
Applicants: GOTO *et al.*
Atty. Docket: 16991.010

Sir:

The following documents are forwarded herewith for appropriate action by the U.S. Patent and Trademark Office (PTO):

1. a Petition to the Director;
2. an Exhibit A;
3. an Exhibit B; and
4. a return postcard.

Please stamp the attached postcard with the filing date of these documents and return it to our courier.

Applicants request that the following fees be charged to Deposit Account No. 50-2387 referencing docket number 16991.010:

\$ 400.00 petition fee

In the event that extensions of time beyond those petitioned for herewith are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned. Applicants do not believe any fees, other than the petition fee (\$400.00), are due in conjunction with this filing. However, if any additional fees are required in the present application, including any fees for extensions of time, then the Commissioner is hereby authorized to charge such fees to Arnold & Porter LLP Deposit Account No. 50-2387 referencing matter number 16991.010. A duplicate copy of this letter is enclosed.

Respectfully submitted,



David R. Marsh (Reg. No. 41,408)
Kristan L. Lansbery (Reg. No. 53,183)

Enclosures



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

GOTO *et al.*

Appln. No.: 08/915,004

Filed: August 20, 1997

For: ***NOVEL PROTEINS AND
METHODS FOR PRODUCING
THE PROTEINS***

Art Unit: 1636

Examiner: M. Pak

Atty. Docket: 16991.010

Confirmation No.: 9564

PETITION TO THE DIRECTOR

Mail Stop - Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Responsive to the Decision on Petition mailed March 17, 2006 ("Decision"), Applicants hereby petition the Director of the U.S. Patent and Trademark Office ("the Office") to reconsider the Decision dismissing the petition to extend the patent term extension ("PTE") in the above-identified application. The Decision reduced the PTE to 0 days in error. This petition for reconsideration is timely-filed within two months of mailing of the Decision.

The examination delay due to interference proceedings in this application begins on November 23, 1998, the date the first Notice of Suspension was mailed. Prosecution remained closed in this matter until the Notice of Allowance was issued almost seven years later. As such, Applicants respectfully request that the above-referenced application be given the maximum extension of five years or 1825 days.

05/17/2006 SZEWDIE1 00000110 502387 00915004
01 FC:1462 400.00 DA

Statement of Facts

1. The instant application was filed on August 20, 1997. As such, 37 C.F.R. §1.701 determines the amount of PTE. Under 37 C.F.R. §1.701(b), the term of a patent entitled to extension is calculated by the sum of delay under paragraphs (c)(1), (c)(2), (c)(3), and (d). The administrative delay affecting patent term in the instant application falls under 37 C.F.R. §1.701(c)(1)(ii), the number of days in the period beginning on the date prosecution in the application was suspended by the Office due to interference proceedings and ending on the date of termination of the suspension.
2. November 23, 1998 was the date prosecution in the instant application was suspended by the Office due to interference proceedings. The Notice of Suspension, mailed on November 23, 1998, stated, "All claims are allowable. However, due to a potential interference, *ex parte* prosecution is SUSPENDED FOR A PERIOD OF SIX (6) MONTHS from the date of this letter." (emphasis in original).
3. Following the suspension period, on June 8, 1999, July 16, 1999, August 4, 1999, Applicants submitted a status inquiry regarding the status of the instant application.
4. On August 31, 1999 another Notice of Suspension due to potential interference was mailed from the Office. Then, on March 8, 2000, April 10, 2000, May 10, 2000, Applicants submitted a status inquiry regarding the status of the instant application.
5. On June 8, 2000, another Notice of Suspension due to potential interference was mailed from the Office. Following this suspension period, Applicants submitted a status inquiry regarding the status of the instant application on December 11, 2000 and March 5, 2001.
6. On March 21, 2001, a communication from the Office was mailed, indicating that the above-identified application was to continue to be suspended due to a potential interference and/or the publication of prior art under 35 U.S.C. §102(e). The Office also requested certified translations of the priority documents. The Patent Application Information Retrieval (PAIR) access site suggests that this is the beginning of the examination delay resulting in PTE.

7. On April 9, 2001, Applicants responded to the March 21, 2001 communication by filing certified translations of the priority documents. Thereafter, inquiries concerning the continued suspension of action were submitted on July 31, 2002, October 7, 2002, December 20, 2002, March 5, 2003 and May 27, 2003.

8. On June 19, 2003, a Petition to the Commissioner was filed requesting status information. In response, Applicants received a Decision on Petition, mailed December 16, 2003, indicating that the application remained suspended due to a possible interference and was to be forwarded “[w]ithin a few days” to the Board of Patent Appeals and Interferences (BPAI) to determine whether an interference would be declared. Applicants note that in this Decision on Petition, mailed December 16, 2003, the Office refers to suspension of prosecution on March 21, 2001 (the date previously alleged in PAIR as the beginning of the delay resulting in PTE).

9. A substitute specification was filed on February 17, 2004, and Applicants filed inquiries for status information on April 28, 2004 and July 1, 2004.

10. The suspension finally terminated on September 7, 2005 when the Notice of Allowance was mailed.

11. The Determination of Patent Term Extension under 35 U.S.C. §154(b) mailed on September 7, 2005 proposed a PTE of 1631 days.

12. On November 7, 2005, Applicants filed a Petition to the Commissioner (“First Petition”) arguing that the proposed PTE contained an error regarding the date the suspension period began.

13. Applicant’s First Petition was denied in the Decision, which further suggested that Applicants are not due any extension of patent term. The Office stated that “the suspension was due to a potential interference with applicant’s application and another patent or application, not to await the result of interference in another application.” Decision at page 2.

Summary of Arguments

On March 17, 2006, the Office issued the Decision that is the subject of the present Request. In this Decision, the Office dismissed Applicants' First Petition, which requested that the patent term be extended by the number of days in the period beginning on the date prosecution in the application was suspended by the Office due to interference proceedings and ending on the date of the termination of the suspension. The Office responded that the provisions of 37 C.F.R. §1.701(c)(1)(ii) apply to suspensions by the Office due to interference proceedings under 35 U.S.C. §135(a) and that, in the instant application, there were no interference proceedings.

In short, the Office asserts that because an interference was never declared, no proceeding under 35 U.S.C. §135(a) occurred. This position cannot be sustained. It completely ignores the Office publication entitled United States Patent Practice in a Post Uruguay Round World ("Office Publication"). Patent and Trademark Office United States Department of Commerce, www.uspto.gov/web/offices/com/doc/uruguay/gatttalk.pdf. The Office Publication clearly states that "[a]pplications suspended by the Office due to interference determination but not involved in interference may be extended for period of suspension" and that patent term extensions compensate for delays beyond control of applicant. Office Publication at pages 12 and 70. *See* Exhibit A. Moreover, although the Office professes that there was no interference proceeding regarding this application, no other explanation is provided for the almost seven-year delay. Applicants understand that the suspension was part of Office processing pursuant to 35 U.S.C. §135(a) and respectfully request clarification if the Office contends otherwise.

Furthermore, the Decision on Petition mailed December 16, 2003 expressly states that the Board of Patent Appeals and Interferences (BPAI) would be involved in determining whether an interference would be declared in this application. Applicants understand proceedings taken by the BPAI in determining whether an interference will be declared to be interference proceedings under

35 U.S.C. §135(a). As such, the Office can not reasonably maintain that the suspensions initiated by the Office in this case were not interference proceedings under §135(a).

The Office seems to interpret that 37 C.F.R. §1.701 (c)(1)(ii) only applies where a suspension is due to awaiting the result of interference in another application. *See* Decision at page 2. However, when 37 C.F.R. §1.701(c)(1) is read in context, the only reasonable interpretation instructs that the period of delay equals the sum of the periods of delay with respect to each interference that the application was involved and the number of days during the suspension period due to interference proceedings under 35 U.S.C. §135(a) not involving the application, *e.g.*, the delay before an interference is declared or the delay where an interference is eventually not declared. In contrast, the Office has interpreted 37 C.F.R. §1.701 (c)(1)(ii) to only apply in instances which are so rare as to not even be provided for in the Manual of Patent Examining Procedure (MPEP). MPEP §709. (Awaiting a new reference and possible interference are the only reasons provided for suspension of action at the initiative of the Office.)

The PTE for this application should be the maximum 5 years regardless of whether the suspension was due to a potential interference with applicant's application and another patent or application or due to awaiting the result of interference in another application. Applicants respectfully note that PAIR indicates that a letter of suspension was mailed "due to interference in another application." *See* Exhibit B at March 21, 2001. Yet the Decision expressly states that the suspension was "not to await the result of interference in another application." Decision at page 2.

Conclusion

Applicants respectfully petition the Commissioner to review the PTE calculation and request a correction to the 5 year maximum or 1825 days.

The fee (37 C.F.R. §1.17(f)) may be \$400.00 for this petition. If so, the United States Patent and Trademark Office is hereby authorized to charge said fee, or a greater one if applicable, to our Deposit Account No. 50-2387. A duplicate copy of this petition is enclosed.

In the event that extensions of time beyond those petitioned for herewith are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned. Applicants do not believe any fees are due in conjunction with this filing. However, if any fees are required in the present application, including any fees for extensions of time, authorization to charge such fees is given in the accompanying transmittal letter.

Respectfully submitted,



David R. Marsh (Reg. No. 41,408)
Kristan L. Lansbery (Reg. No. 53,183)

Date: May 16, 2006

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United States Patent Practice in a Post Uruguay Round World

**Patent and Trademark Office
United States Department of Commerce**



Patent Term Extensions

(Rule 701)

Interference Proceedings

Under §135

**Extension Equal to Days in Period Beginning
on Date Interference Declared and Ending on
Date Interference Terminated**

**Applications Suspended by the Office Due to
Interference Determination But Not Involved in
Interference May Be Extended for Period of
Suspension**

**Patent and Trademark Office
United States Department of Commerce**

Merits of the New System (cont'd)

**Patent Term Extensions Compensate For
Delays Beyond Control of Applicant
Applications Pending Today that Mature into
Patents Will Have At Least 17 Years of Rights
Provisional Applications Will Help Many
Inventors**

- Safety Valve for “Unexpected” Inventor Bar Dates
- Permits Inexpensive Updating of Disclosures
- Permits Deferral of Patent Term

**Patent and Trademark Office
United States Department of Commerce**



Search results as of: 05-01-2006::17:34:58 E.T.

Patent Term Extension

Filing or 371(c) Date:	08-20-1997	USPTO Delay (PTO) Delay (days):	1631
USPTO Adjustment (days):	+0	Corrections (APPL) Delay (days):	1631
Explanation Of Calculations		Total Patent Term Extension (days):	0

Patent Term Extension History

Date	Contents Description	PTO(Days)	APPL(Days)
03-17-2006	Adjustment of PTE Calculation by PTO		1631
09-07-2005	Mail Notice of Allowance		↑
09-06-2005	Notice of Allowance Data Verification Completed	1631	
07-01-2004	Information Disclosure Statement (IDS) Filed	↑	
04-28-2004	Miscellaneous Incoming Letter	↑	
02-17-2004	Substitute Specification Filed	↑	
02-17-2004	New or Additional Drawing Filed	↑	
02-25-2004	CRF Is Good Technically / Entered into Database	↑	
01-15-2004	Correspondence Address Change	↑	
12-16-2003	Petition Decision - Granted	↑	
06-19-2003	Petition Entered	↑	
05-27-2003	Miscellaneous Incoming Letter	↑	
12-20-2002	Miscellaneous Incoming Letter	↑	
07-24-2002	Correspondence Address Change	↑	
07-25-2002	Change in Power of Attorney (May Include Associate POA)	↑	
11-01-2001	Case Docketed to Examiner in GAU	↑	
10-09-2001	Interference Communication: Initial Memo Disposal	↑	
09-27-2001	Date Forwarded to Examiner	↑	
09-21-2001	to Close the A/R Record and Reset the Status for Expired Suspensions.	↑	
05-29-2001	Information Disclosure Statement (IDS) Filed	↑	
04-11-2001	Certified Translation of Specification Filed	↑	
03-21-2001	Mail Suspension Due to Interference in Another Application	↑	
03-21-2001	Letter of Suspension - Interference in Another Case	↑	
03-21-2001	Mail Miscellaneous Communication to Applicant		
03-21-2001	Miscellaneous Action with SSP		
03-08-2001	Miscellaneous Incoming Letter		
01-11-2001	Date Forwarded to Examiner		
12-14-2000	Miscellaneous Incoming Letter		
06-08-2000	Mail Letter of Suspension		
06-08-2000	Letter of Suspension - Examiner Initiated		
05-12-2000	Miscellaneous Incoming Letter		
04-13-2000	Miscellaneous Incoming Letter		
03-14-2000	Miscellaneous Incoming Letter		
08-31-1999	Mail Letter of Suspension		

08-31-1999	Letter of Suspension - Examiner Initiated
08-30-1999	Mail Miscellaneous Communication to Applicant
08-30-1999	Miscellaneous Action with SSP
08-09-1999	Miscellaneous Incoming Letter
07-19-1999	Miscellaneous Incoming Letter
06-10-1999	Miscellaneous Incoming Letter
11-23-1998	Mail Letter of Suspension
11-23-1998	Letter of Suspension - Examiner Initiated
11-23-1998	Mail Miscellaneous Communication to Applicant
11-23-1998	Miscellaneous Action with SSP
11-05-1998	Information Disclosure Statement (IDS) Filed
10-29-1998	Examiner Interview Summary Record (PTOL - 413)
10-28-1998	Date Forwarded to Examiner
10-16-1998	Amendment after Final Rejection
10-16-1998	Substitute Specification Filed
10-16-1998	Request for Foreign Priority (Priority Papers May Be Included)
10-16-1998	Request for Extension of Time - Granted
07-06-1998	Mail Final Rejection (PTOL - 326)
07-06-1998	Final Rejection
05-22-1998	Date Forwarded to Examiner
04-27-1998	Response after Non-Final Action
04-27-1998	Request for Extension of Time - Granted
01-26-1998	Information Disclosure Statement (IDS) Filed
12-22-1997	Mail Non-Final Rejection
12-19-1997	Non-Final Rejection
12-01-1997	CRF Is Good Technically / Entered into Database
08-20-1997	Preliminary Amendment
11-25-1997	Case Docketed to Examiner in GAU
11-17-1997	Application Dispatched from OIPE
11-05-1997	IFW Scan & PACR Auto Security Review
09-09-1997	Initial Exam Team nn
06-12-2001	Dummy Standard Action - DO Not DELETE

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